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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Nobutaka MAGOME et al.

Group Art Unit: 2886

Application No.: 10/594,509

Examiner: H. PHAM

Filed: September 28, 2006

Docket No.: 128815

For: EXPOSURE APPARATUS, EXPOSURE METHOD AND DEVICE MANUFACTURING METHOD, AND SURFACE SHAPE DETECTION UNIT

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the October 24, 2008 Restriction Requirement, Applicants provisionally elect Group I, claims 1-25 as classified in class 356 and subclass 121, with traverse.

National stage applications filed under 35 U.S.C. §371 are subject to unity of invention practice as set forth in PCT Rule 13, and are not subject to U.S. restriction practice. *See* MPEP §1893.03(d). Thus, the Restriction Requirement is improper and must be withdrawn. This application is a national stage of PCT Application No. PCT/JP2005/006071.

Further, PCT Rule 13.1 provides that an "international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept." PCT Rule 13.2 states:

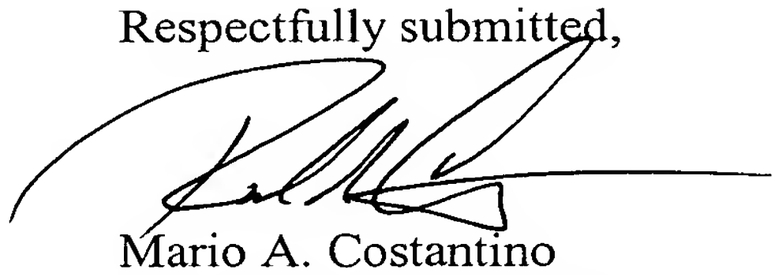
> Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical

> features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

A lack of unity of invention may be apparent "*a priori*," that is, before considering the claims in relation to any prior art, or may only become apparent "*a posteriori*," that is, after taking the prior art into consideration. *See* MPEP §1850(II), quoting *International Search and Preliminary Examination Guidelines* ("ISPE") 10.03. Lack of *a priori* unity of invention only exists if there is no subject matter common to all claims. *Id.* If *a priori* unity of invention exists between the claims, or, in other words, if there is subject matter common to all the claims, a lack of unity of invention may only be established *a posteriori* by showing that the common subject matter does not define a contribution over the prior art. *Id.* The Restriction Requirement has not established that there is a lack of unity of invention.

Reconsideration and withdrawal of the restriction and election of species requirement are respectfully requested.

Respectfully submitted,



Mario A. Costantino
Registration No. 33,565

Richard A. Castellano
Registration No. 61,961

MAC:RAC/sxl
Date: November 19, 2008

OLIFF & BERRIDGE, PLC
P.O. Box 320850
Alexandria, Virginia 22320-4850
Telephone: (703) 836-6400

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